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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,575	05/25/2006	Jin Fujino	SHIGA1.005APC	5358

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EXAMINER

HEYER, DENNIS

ART UNIT	PAPER NUMBER
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1615

NOTIFICATION DATE	DELIVERY MODE
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08/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/580,575	Applicant(s) FUJINO ET AL.	
	Examiner DENNIS HEYER	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/1/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/13/2009, 3/26/2007, 5/25/2006, 7/21/2009, 7/28/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1 – 11 are currently pending

Election/Restrictions

Applicants' election of group I (Claims 1 – 7) with traverse, in the reply filed on June 1, 2009 is acknowledged. The traversal is on the ground(s) that the Fujino reference (Fujino *et al.* US 2006/0286133) cited in the restriction requirement does not qualify as prior art. Applicant's argument is found persuasive with respect to the previously cited Fujino reference.

However, with respect to the reasons cited herein for the references Misaki *et al.* in JP11-262653 A and Junichi *et al.* in JP07-185294, in view of Streitweiser *et al.* in Introduction to Organic Chemistry, 3rd Edition, Macmillan, 1985, applied to the 103 rejection below, there is no special technical feature, linking the invention of Groups I and II (see below, Groups taken from page 2, of restriction requirement filed March 2, 2009) to form a single general inventive concept.

Group I, claim(s) 1 - 7 drawn to an oil-in-water cosmetic composition

Group II, claim(s) 8 - 11, drawn to a method of producing an oil-in-water cosmetic composition.

As set forth in Rule 13.1 of the Patent Cooperation Treaty (PCT), "the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." Moreover, as stated in PCT Rule 13.2, "where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features." Furthermore, Rule 13.2 defines "special technical features" as "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of Group I, as recited in Claim 1, is a composition comprising an oil-in-water composition comprising a polyglycerin fatty acid ester, an oily component and water. The composition of Claim 1 is disclosed by Misaki *et al.* in JP11-262653 A and Junichi *et al.* in JP07-185294, in view of Streitweiser *et al.* in Introduction to Organic Chemistry, 3rd Edition, Macmillan, 1985. The combination of these references teaches the elements of instant Claim 1. Therefore, the elements of the subject matter relating to instant Claim 1 are at least obvious over the prior art.

As such, Group I does not share a special technical feature with the instant claims of Group II. Therefore, the claims are not so linked within the meaning of PCT

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Rule 13.2 so as to form a single inventive concept, and unity between Groups I and Groups II is broken.

Claims 1 – 7 (Group I) will be examined in the instant Office Action.

Priority

This application, 10/580,575 is a national stage entry of *PCT/JP2004/17459*, International Filing Date: November 25, 2004. This application claims foreign priority under 35 U.S.C. § 119(a)-(d) to Japanese Patent Applications 2003-400590, filed November 28, 2003 and 2004-186841, filed June 24, 2004.

Claim rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Instant Claims 1, 2 and 5 – 7 are rejected as being unpatentable over Misaki *et al.* in JP11-262653 A; publication date: September 28, 1999 and Junichi *et al.* in JP07-185294; publication date: July 25, 1995, in view of Streitweiser *et al.* in Introduction to Organic Chemistry, 3rd Edition, Macmillan, 1985. For ease of examination, the Examiner relied upon an English language translations of the JP11-262653 A and JP07-185294 A publications. All citations henceforth to Misaki and Junichi are located in the English language translations.

Regarding instant Claim 1, Component A, Misaki *et al.* teaches oil-in-water (OIW) cosmetic compositions (paragraph [0001]) comprising a polyglycerin fatty acid ester, oily matter (an oily component) and water (Claims 1 and 2). The limitation on the hydroxyl value of polyglycerin fatty acid ester (component A) is taught in Table 1 as ranging from 588 – 606. The limitation on 50 – 100 % by mass of fatty acid residues of Component A is taught in Claims 1 and 2, (75 weight % or more of oleic acid; a C-18 fatty acid, as taught by Streitweiser, page 509 – 510). The limitation on the amount of Component A is taught as 0.1 – 30 % (Claims 1 and 2).

Regarding instant Claim 1, Component B, an oily component, Misaki teaches 'oily matter' as Component C of the oil-in-water emulsion in from 0.1 to 20 % by mass (Claims 1 and 2).

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Regarding instant Claim 1, Component C, water, Misaki teaches water as Component D of the oil-in-water emulsion ranging from 5 to 98% by mass (Claims 1 and 2).

Regarding instant Claim 2, the further limitation on ranges of Components A, B and C is taught by Misaki (Claims 1 and 2).

Regarding instant Claim 5, as noted in the rejection of instant Claim 1, oleic acid is taught Misaki as a fatty acid residue (Claims 1 and 2).

Regarding instant Claim 6, the thickener is taught by Misaki as xanthan gum (paragraph [0017]. Although not described as a thickener by Misaki, xanthan gum is included in examples of thickeners on page 18, line 21 of the instant specification.

Regarding instant Claim 7, Misaki teaches that the oil-in-water composition may be used as a body lotion (paragraph [0019]) which reads on, for example, shampoo and facial cleansing cream.

Misaki does not teach the polymeric subcomponents of Component A (dimer, trimer of cyclic polyglycerin etc.).

Junichi *et al.* teach polyglycerine fatty acid esters synthesized by esterifying a polyglycerine composition in a two step procedure (Abstract). In a first step, the polyglycerine constituent is prepared using a condensation reaction with glycerol and epichlorohydrin followed by, in a second step, reacting said polyglycerine with a free fatty acid (such as oleic acid) and a catalyst to produce the polyglycerine fatty acid ester (Component A) (paragraph [0013]). The hydroxylation value of these polyglycerine fatty

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acid ester products is disclosed to range from 320 - 610 and the presence of branching and cyclic structures is also taught (Abstract).

When read in light of the specification (page 13, lines 3 – 21), instant Component A may also be prepared using the epichlorohydrin condensation procedure followed by reaction of a free fatty acid and a catalyst to afford materials with a hydroxyl value in a range which substantially overlaps with the teachings of Junichi. Thus, the procedure used in the instant application appears to be identical to that used by Junichi to prepare polyglycerine fatty acid esters with a range of hydroxyl values that overlaps the instantly claimed range. Therefore, it is the position of the examiner, absent specific evidence to the contrary, that instant Component A is identical to the polyglycerine fatty acid esters taught by Misaki as it's method of preparation, condensation of glycerol and epichlorohydrin followed by fatty acid incorporation is an art recognized method (Junichi *et al.*) of preparing such materials. Thus, it would have been *prima facie* obvious to one of ordinary skill in the art, at the time the invention was made, to prepare Component A using the two step procedure taught by Junichi to provide polyglycerine fatty acid esters with hydroxyl values within the instantly claimed range.

Instant Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misaki *et al.* in JP11-262653 A; publication date: September 28, 1999, Junichi *et al.* in JP07-185294; publication date: July 25, 1995 and Streitweiser *et al.* in Introduction to Organic Chemistry, 3rd Edition, Macmillan, 1985, as applied to instant Claims 1, 2 and 5 – 7, and further in view of Biatry in US patent 6,506,391; published January 14, 2003.

As noted in the 103(a) rejection above, Misaki and Junichi in view of Streitweiser teach the limitations of instant Claims 1 and 2.

Regarding instant Claims 3 and 4 drawn to an OIW composition comprising a polyglycerin fatty acid ester with a hydroxyl value ranging from 550 – 700, an oily component and water, Misaki teaches, as noted in the rejection Instant Claim 1, this limitation on paragraph [0025], Table 1 (see Claims 1 and 2 for the instantly Claimed ranges). Regarding the added limitation that the OIW of instant Claim 1, further comprise Component D, a polyhydric fatty acid ester (excluding Component A) with a hydroxyl value of 100 to 500, Misaki does not teach polyhydric fatty acid esters with this range of hydroxyl values. It is noted however, as defined in the instant specification (page 17, lines 1 – 7), the term ‘polyhydric’, includes polyglycerin fatty acid esters of which, diglyceryl monooleate is disclosed.

Biatry teaches OIW cosmetic compositions comprising specific amphiphiles which are capable of stabilizing OIW emulsions by forming cubic gel particles (column 1, lines 55 – 63). Biatry teaches that amphiphiles such as polyglycerin fatty acid esters (taught as diglycerol monoesters), and specifically diglyceryl monooleate, are capable of forming the lamellar phase of such stabilized OIW emulsions (column 2, lines 33 – 37). The limitation on the range of Component D (1 – 100%) is taught by Biatry on column 3, lines 5 – 16. Note that Biatry is silent on the hydroxyl value of diglyceryl monooleate; however, as diglyceryl monooleate is disclosed as a most preferable polyglycerin fatty acid ester, the compound is presumed to meet this limitation.

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Thus, it would have been *prima facie* obvious to one of ordinary skill in the art, at the time the invention was made, to add a polyhydric fatty acid ester, specifically, diglycerol monooleate, as this compound is art-recognized to stabilize of OIW emulsions.

Conclusion

Claims 1 – 7 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DENNIS HEYER whose telephone number is (571)270-7677. The examiner can normally be reached on Monday-Thursday 8AM-5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached at (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DH

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615